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Serial No. 10/634,990

PATENT

REMARKS

In the Office Action, the Examiner noted that Claims 34-61 are pending in the application, and that Claims 1-33 and 62-67 are withdrawn from consideration. In addition, the Examiner noted that Claims 37, 41-45 and 49-52 are allowable over the prior art of record. **Applicant graciously acknowledges the Examiner's indication of allowable subject matter.**

By this Amendment, Claims 34, 37-39, 41, 43, 50, 55, 56, 59 and 61 have been amended, and Claims 1-33, 42 and 62-67 have been cancelled without prejudice or disclaimer. In addition, new claims 68-69 have been added. Thus, Claims 34-41, 43-61 and 68-69 are presented for examination. Applicant respectfully submits that no new matter has been introduced into the present application, and that the amendments to the claims are supported by the originally filed specification and drawings.

The Examiner's rejections are traversed below.

Rejection Under 35 USC Section 112, Second Paragraph

Claims 37-39, 43-45, 49 and 61 are rejected under 35 U.S.C. Section 112, Second Paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Applicant considers the claims to be sufficiently

clear. Nevertheless, Applicant has amended the claims to correct informalities, which do not affect the scope of the claims.

Applicant has in addition further amended the claims to make express that which is inherent in the claims and/or to correct cosmetic informalities in the claims. Accordingly, Applicant respectfully submits that claims 37-39, 43-45, 49 and 61 satisfy the requirements under Section 112, second paragraph.

Withdrawal of this rejection is respectfully requested.

Rejection Under 35 USC Section 103, Second Paragraph

Claims 38-40, 46-48 and 53-61 are rejected as being unpatentable based on one or more of the following prior art references: Hoffmann U.S. Patent 4,181,555; and Voltmer et al. U.S. Patent 4,502,910 combined with Vijuk U.S. Patent 6,273,411.

Applicant respectfully traverses this rejection.

Specifically, U.S. Patent 4,181,555 entitled "Labeling apparatus and method for continuously severing labels from continuous label stock and applying the severed labels to containers," relates to a continuous labeling apparatus and method for applying labels to containers. A continuous label stock **which is pre-printed** is fed between an anvil roller and a

rotary die, and labels are severed, scrap material is rewound, and each severed label is picked up by a rotary vacuum drum and is supplied to a label applying station where the drum and a container feed come together. Thus, this prior art reference does not at all relate to the present invention that prepares **customer specific orders**. In addition, this prior art reference does not at all **reduce the label size**, which is one of the optional significant benefits of the present invention.

U.S. Patent 4,502,910 entitled "Literature applying mechanism" includes a label application device for packaging equipment, and uses adhesive covered tape from which labels are peeled by bending over peel bar edge. The system dispenses literature carried by a conveyor, and includes a tape for the application of adhesive to literature, and a device for the separation of the literature from the tape to permit the securing of the literature, adhesively, to the containers. A drive mechanism is provided for advancing the tape through successive increments of distance, each incremental distance being equal to the size of one piece of literature. A hopper dispenses the literature to the tape, one piece at a time. The literature separation device includes a bar having an edge about which the tape is bent to free the literature from the tape as the tape advances around the edge. The adhesive is retained by the literature during the separation from the tape so as to permit the adhesive attachment of the pieces of literature to the containers. Thus, this prior art reference also does not at all relate to the present invention that prepares customer specific orders. In addition, this prior art reference does not at all reduce the label size, which again is one of the significant benefits of the present invention.

U.S. Patent 6,273,411 entitled "Booklet forming method and apparatus" relates to a method of forming a **booklet** from a single sheet of paper by depositing an adhesive along a linear path on a single sheet of paper and folding the sheet by making folds parallel to first direction, to form interconnected panels. The lateral edges of the panels are cut off so that the panels are no longer interconnected. A fold is made along a line coincident with the linear path to form the booklet. The booklet may be further folded with close folds to obtain a compact outset. Accordingly, this prior art reference does not at all discuss or relate to customer specific labels. In addition, there is no motivation or suggestion to utilize this prior art references for the labeling of patient specific pharmaceutical and/or prescription orders.

Previously presented and/or currently amended Claims 38-40, 46-48 and 53-61 have been amended in accordance with the Examiner's indication of allowable subject matter already being claimed in the present application and/or arguments presented herein. Accordingly, these claims recite subject matter that is not considered to be a narrowing description, but rather recite subject matter that Applicant considers to be commensurate with the scope of protection of the present invention, as well as any equivalents that are substantially similar to the presently claimed invention.

New Claims 68-69 have been added in accordance with the Examiner's indication of allowable subject matter and/or arguments presented herein. Accordingly, these claims also recite subject matter that is not considered to be a narrowing description, but rather recite subject matter that Applicant considers to be commensurate with the scope of protection of the present

invention, as well as any equivalents that are substantially similar to the presently claimed invention.

CONCLUSION

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicant reserves the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicant hereby retracts any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicant specifically retracts statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

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For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

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AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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